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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,486	02/24/2004	Robert Levin	SES 2539.1.1	6761
2147 7590 04/04/2011				
GRACE J FISHEL				
2200 WEST PORT PLAZA DRIVE				
SUITE 202				
ST. LOUIS, MO 63146				
EXAMINER				
COLLINS, DOLORES R				
ART UNIT		PAPER NUMBER		
3711				
MAIL DATE		DELIVERY MODE		
04/04/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/787,486

Applicant(s)

LEVIN, ROBERT

Examiner

DOLORES COLLINS

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-949)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/24/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Based upon consideration of all the relevant factors with respect to the claims as a whole, Claim(s) 1 & 3 are held to claim an abstract idea, and are rejected as ineligible subject matter under 35 U.S.C. 101.

The rationale for this finding is explained below, which is a result of careful consideration of the listed factors when analyzing the claims as a whole to evaluate whether a method claim is directed to an abstract idea. These factors are not intended to be exclusive or exhaustive.

I. Factors weighing toward eligibility are:

a) Recitation of a machine or transformation: In particular, machine or transformation meaningfully limits the execution of the steps, a machine implements the claimed steps, the article being transformed is particular, an object or substance, the article undergoes a change in state or thing (objectively different function or use);

b) Practically applying a law of nature to meaningfully limit the execution of the steps; or

c) The claim is more than a mere statement of a concept: It describes a particular solution of the problem to be solved; implements a concept in a tangible way, performance of steps are observable and verifiable.

II. Factors weighing against eligibility are:

a) No recitation or insufficient recitation of a machine or transformation:

+ Insufficient involvement of the machine or transformation, merely nominally, insignificantly, or intangibly related to the performance of the steps, (e.g., data gathering, or merely recites a field in which the method is intended to be applied).

+ Machine is generically recited such that it covers any machine capable of performing the claimed step(s) or merely an object on which the method operates.

+ Transformation involves only a change in position or location of the article.

b) Improperly applying a law of nature that would monopolize a natural force or patent a scientific fact (e.g., by claiming every mode of producing an effect of that law of nature); or applied in a merely subjective determination or merely nominally, insignificantly, or tangentially related to the performance of the steps; or

c) The claim is a mere statement of a general concept: Use of the concept, as expressed in the method, would effectively grant a monopoly over the concept; or both known and unknown uses of the concept are covered, and can be performed through any existing or future-devised machinery, or even without any apparatus; or states only a problem to be solved; or general concept is disembodied; or mechanism by which the step(s) are implemented is subjective or imperceptible.

+ Examples of general concepts: Basic economic practices or theories, basic legal theories, mathematical concepts, mental activity, interpersonal relations or relationships, teaching concepts, human behavior, and instructing how business should be conducted.

Claim 1 is ineligible subject matter because the claimed limitations include no recitation or insufficient recitation of a machine or transformation, or not directed to a proper application of a law of nature, or just a mere statement of a general concept.

Dependent Claim 3 when analyzed as a whole is/are held to be ineligible subject matter and are rejected under 35 U.S.C. 101 because the additional recited limitations fail to establish that the claim is not directed to an abstract idea as detailed below:

The above claims have not been rejected prior to this action under 35 USC 101 because the supreme courts had not made a decision regarding Bilski at that juncture. See the Federal Register notice entitled "Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos (Fed. Reg. Vol. 75, No. 143/Tuesday, July 27, 2010/Notices) for a complete list of factors that were considered by the examiner in the above analysis.

The Supreme Court has indicated that the machine or transformation test is "not the sole test for patent eligibility", but that it may be a "useful and important clue or investigative tool" for deciding whether an invention is a patent eligible process under 35 USC 101.

In this case, the facts that no particular machine is required to perform the claimed method steps, nor do the steps result in any transformation of a particular article, are indicators that applicant's are attempting to patent an abstract idea. None of the steps are performed by a machine, but rather are performed by a human being.

Please excuse the delay in prosecution

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited to show the state of art with respect to features of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DOLORES COLLINS** whose telephone number is **(571)272-4421**. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Eugene Kim** can be reached on **(571) 272-4463**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

/DOLORES COLLINS/
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/ALVIN A HUNTER/
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/DONALD T HAJEC/
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